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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/759,481	01/16/2004	Peter Navratil	KLR:1016.2025	7575

7590 10/03/2005  
Kevin L. Russell  
Chernoff, Vilhauer, McClung & Stenzel, LLP  
601 SW Second Avenue  
Portland, OR 97204-3157

EXAMINER
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TANG, MINH NHUT

ART UNIT	PAPER NUMBER
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2829

DATE MAILED: 10/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/759,481

Applicant(s)

NAVRATIL ET AL.

Examiner

Minh N. Tang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 July 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 January 2004 and 15 July 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Drawings*

1. The drawings were received on July 15, 2005. These drawings are acceptable.

### *Specification*

2. The disclosure is objected to because of the following informalities: on page 8, line 4, "112a-112d" should be -- 112A-112D --.

Appropriate correction is required.

### *Claim Objections*

3. Claim 3 is objected to because of the following informalities: in claim 3, line 3, "said first and second platen" should be -- said first platen and said second platen --.

Appropriate correction is required.

### *Double Patenting*

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

5. Claims 1 and 10 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 1 of prior U.S. Patent No. 6,777,964 B2. This is a double patenting rejection.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-7 and 9 are rejected under 35 U.S.C. 102(b) as being anticipated by Kaplan et al. (U.S.P. 6,096,567).

As to claim 1, Kaplan et al. discloses, in Fig. 1, a probe station (100) for testing a device under test (112) comprising a first platen (140, 130) supporting an electrical probe (132); a chuck (102) supporting said device under test (112); a second platen (150) supporting an optical probe (120); said first platen (140, 130) positioned above said device under test (112) and said second platen (150) positioned above said device under test (112); at least 70% of the top surface (i.e., upper surface) of said second platen (150) terminating in free space when said optical probe (120) is not supported thereon.

As to claim 2, Kaplan et al. discloses in Fig. 1, at least 80% of the top surface (i.e., upper surface) of said second platen (150) terminating in free space when said optical probe (120) is not supported thereon.

As to claim 3, Kaplan et al. discloses in Fig. 1, said first platen (140, 130) and said second platen (150) are capable of relevant movement with respect to one another.

As to claim 4, Kaplan et al. discloses in Fig. 1, at least 85% of the top surface (i.e., upper surface) of said second platen (150) terminating in free space when said optical probe (120) is not supported thereon.

As to claim 5, Kaplan et al. discloses in Fig. 1, at least 90% of the top surface (i.e., upper surface) of said second platen (150) terminating in free space when said optical probe (120) is not supported thereon.

As to claim 6, Kaplan et al. discloses in Fig. 1, at least 95% of the top surface (i.e., upper surface) of said second platen (150) terminating in free space when said optical probe (120) is not supported thereon.

As to claim 7, Kaplan et al. discloses in Fig. 1, said second platen (150) has a greater top surface area than said first platen (130).

As to claim 9, Kaplan et al. discloses in Fig. 1, said second platen (150) has the same surface area as said first platen (140).

8. Claims 1 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fujihara et al. (U.S.P. 5,410,259).

As to claim 1, Fujihara et al. discloses, in Figs. 6-8, a probe station (10) for testing a device under test (W) comprising a first platen (1, 9) supporting an electrical probe (9a, Fig. 7); a chuck (4) supporting said device under test (W); a second platen (11, Fig. 8) supporting an optical probe (12); said first platen (1, 9) positioned above said device under test (W) and said second platen (11) positioned above said device under test (W); at least 70% of the top surface (i.e., upper surface) of said second

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platen (11) terminating in free space when said optical probe (12) is not supported thereon.

As to claim 8, Fujihara et al. discloses in Figs. 6-8, said second platen (11) has a small top surface area than said first platen (1, 9).

### ***Response to Arguments***

9. Applicant should submit an argument under the heading "Remarks" pointing out disagreements with the examiner's contentions. Applicant must also discuss the references applied against the claims, explaining how the claims avoid the references or distinguish from them.

10. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:


Fyfield	6,927,079	Method For Probing A Semiconductor Wafer.
Hembree	6,774,651	Method For Aligning And Connecting Semiconductor Components To Substrates.

***Communication***

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Minh N. Tang whose telephone number is (571) 272-1971. The examiner can normally be reached on M-F (7:00-3:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nestor R. Ramirez can be reached on (571) 272-2034. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
MINH NHUT TANG  
PRIMARY EXAMINER  
9/29/05